

REMARKS

Applicants believe that the foregoing comments overcome the rejections set forth in the May 18, 2006 Office Action.

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I. THE EXAMINER'S REJECTIONS

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, 27, and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, U.S. Patent Application Pub. No. 2003/0054888 (hereinafter "Walker") in view of Roll *et al.*, U.S. Patent Application Pub. No. 2002/0016779 (hereinafter "Roll").

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The Examiner rejected independent claims 1, 10, 15, 21 and 22 by applying the same arguments to each claim. More specifically, the Examiner cited Walker to show every element of each of the independent claims; however, the Examiner admitted that Walker does not expressly teach retrieving at least one product information from at least one database storing third-party retail vendor product information. *See, e.g.*, Office Action dated 5/18/2006, page 3. In the Examiner's view, "Roll teaches a system that provides a comparative and variable pricing system that allows users to place an Internet search query fro an item that said users have an interest and received back a comparative list of providers of said item." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products." *Id.*

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Accordingly, the Examiner concluded that the combination of references “would show to users the best third-party vendors’ offers of products selected by users.” *Id.*

5 **II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim
10 limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

15 Indeed, the Examiner “has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination.” *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *see also, In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) (“When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify
20 some suggestion to combine references of make modification.”). A finding of obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or motivation. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail
25 in rejecting the pending claims. “Obviousness cannot be established by combining the teachings

of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

5 More specifically, Applicants respectfully submit that there is no motivation for the combination of Walker in view of Roll. In the present rejection, the Examiner stated, with respect to the combination of Walker in view of Roll that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of “the best third-party vendors’ offers of
10 products selected by users.” *See* Office Action, page 3.

 Applicants respectfully submit that the proffered motivation is improper. Walker discloses a method wherein an individual retailer can increase the excitement associated with the shopping experience. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of
15 the retail store’s products, increasing the overall profitability of the retail store.

 To increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item’s cost. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. The product can be manufactured by a third-party, however, it must be
20 offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits.

 Roll discloses a method wherein a user utilizes a search engine to search for a product by using a program which is accessed from the Internet. After searching for the product, the user

receives a comparative list of retailers (or other entities) that offer the item as well as terms (i.e., the price) for the item. The system, in turn, allows a user to purchase products and services from competing retailers.

As a result, Applicants respectfully submit that the references teach away from each other. As such, they are not combinable. The Walker reference results in increased profits for a single retail store, while Roll teaches a system that is designed for use by multiple retailers which results in lower profits by the retailers via lowered prices to the consumer.

Indeed, in describing the state of the art, Roll describes the typical use of pricing mechanisms as follows:

Heretofore, available pricing mechanisms are primarily designed to promote transactions within either a) the line of service of the entity providing the listing (e.g., web sites, insurance company websites, mortgage company web sites, insurance company web sites, retail stores and discount stores...(Emphasis added) Pg. 1, paragraph 0006.

Roll also discloses the inherent flaws in such a system:

Users may use these various pricing mechanisms in an effort to find the best terms for the purchase of an item. However, the users' motivation can be in conflict with the motivation of the entity providing the pricing information, often the seller. The seller's motivation is oftentimes to maximize profit, which means conducting the highest number of transactions with the highest margin possible. Pg. 1, paragraph 0007.

In short, Roll describes the exact process which is disclosed by that of Walker, namely a seller controlled system designed to maximize internal profits. Roll, however, explicitly lists the teachings of Walker as deficient. Indeed, in light of the deficiencies of a system as disclosed in Walker, one of the objects of Roll's invention is to "enable the purchase of products and services from competing product/service providers." (Emphasis added). Page 1, paragraph 0013.

Accordingly, one of ordinary skill in the art would not be motivated to combine the two references because the references expressly teach away from each other. In addition, the cited

references provide no other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

5 "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

10 Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

15 Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

20 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

25 Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

30 Further, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Roll system to display to users a list of different third-party providers vendors of users' selected products." See Office Action, page 3. However, such

a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker will not operate as intended, by offering its products with the added incentive of a chance to win a product, but rather would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination would show to users the best third-party offers of products selected by users. *See* Office Action, page 3.

It is well settled that “if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner’s proposed modification of Walker in view of Roll would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

Even if the combination of Walker and Roll is proper, the combined references do not disclose the present invention as amended. The resulting system of Walker in view of Roll would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

More specifically, the Examiner contends that Walker teaches the purchase of a product from the third-party retail vendor. *See* Office Action, page 4. Applicants respectfully disagree. Walker does not allow a user to purchase a product from a third-party vendor. Instead, if the

user wins a product, the customer is charged a game fee and receives the item directly from the offeror of the game. *See* Abstract.

In contrast, the present invention comprises an improved shopping search engine. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. Alternatively, the user can simply click on one of the third-party vendor's links and purchase the product. Both options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. As a result, the present invention does not directly offer products for sale.

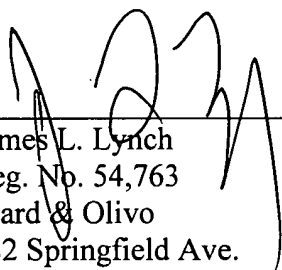
Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further, the cited references neither teach nor suggest the novel and non-obvious features of this invention.

CONCLUSION

Applicants submit that the specification, drawings, and all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current
5 invention and are in no way related to patentability. Early and favorable action is accordingly solicited.

Respectfully submitted,

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